

### **REMARKS**

Claims 16-22 and 25-30 are pending in the instant application. Claims 23 and 24 have been previously cancelled. This Amendment, which amends claim 16, is submitted in response to the Office Action of December 31, 2007. No new matter has been added by these amendments.

The Office Action has rejected all pending claims under 35 U.S.C. §§ 102 and/or 103, and also asserted a provisional non-statutory double patenting rejection. In view of the amendments and remarks, Applicants respectfully request that the rejections be reconsidered and withdrawn.

### **Rejections Under 35 U.S.C. § 102**

Claims 16-22 and 25-27 have been rejected under 35 U.S.C. § 102 as purportedly being anticipated by Orzheshkov *et al.* (SU App. 3299887A) (hereinafter "Orzheshkov"). Applicants respectfully submit that, at a minimum, the claimed invention is novel over Orzheshkov because Orzheshkov fails to teach the connector recited in the amended claims.

The invention, as recited in amended claim 16, is directed to a gauge for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane. The gauge has a body, and a connector is disposed on the body. The connector is used to mount the gauge onto a prosthetic component and a predefined site of a patient simultaneously. This allows correlation between the predefined site of said patient and positioning of the prosthetic component.

Orzheshkov does not teach a connector disposed on the body of a gauge for mounting of the gauge to a prosthetic component and a predefined site of a patient simultaneously. Orzheshkov also does not teach a gauge that allows correlation between the predefined site of said patient and positioning of the prosthetic component.

For a reference to anticipate a claimed invention, it must teach each and every element recited in the claims. MPEP § 2131. Since Orzheshkov fails to teach each and every element recited in claim 16, the invention as recited in claim 16 and its dependents is novel over the reference. As such, Applicants respectfully request reconsideration and withdrawal of this rejection.

**Rejections Under 35 U.S.C. § 103**

Claims 16, 17, 19-22 and 25-27 have been rejected under 35 U.S.C. § 103 as being unpatentable over Leone, Jr. (U.S. Pat. No. 6,302,890) (hereinafter "Leone") in view of Shue *et al.* (U.S. Pat. No. 2,385,424) (hereinafter "Shue").

The invention, as recited in amended claim 16, is directed to a gauge for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane. The gauge has a body, and a connector is disposed on the body. The connector is used to mount the gauge onto a prosthetic component and a predefined site of a patient simultaneously. This allows correlation between the predefined site of said patient and positioning of the prosthetic component.

Leone, viewed in combination with Shue, do not teach the recited connector. On page 4, the Office Action contends that Leone teaches "a connector (12) disposed on said body for connection of said gauge to a prosthetic component of a predetermined site of a patient (Figs. 1-5, Col 5, lines 52-63, Col 7, line 48-Col 8, line 45)." The Office Action only relies on Shue as purportedly teaching a plumb bob, and does not assert that Shue teaches a connector.

However, Leone's purported "connector (12)" is not the recited connector. Instead, Leone teaches an elongated pin (12) having a distal end (14) configured to facilitate anchoring into the pelvis of a patient. The proximal end (18) of the elongated pin (12) is configured to attach to the alignment assembly's mounting member (18) (Leone at column 5, lines 52-63). Thus, Leone's elongated pin does not mount simultaneously onto a prosthetic component and a predefined site of a patient. This feature is likewise not taught by Shue.

Therefore, viewing Leone and Shue together, the combination does not make obvious the invention as recited in claim 16 or, claims 17, 19-22 and 25-27, which ultimately depend from claim 16. Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

**Provisional Double Patent Rejection**

Claims 16-30 have been provisionally rejected as purportedly unpatentable over claims 161-193 in co-pending U.S. App. No. 10/494,085 ("the co-pending '085 application") on the grounds of non-statutory double patenting. As of the date of this Amendment, claims 161-193 in the co-pending '085 Application have not been allowed. As

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such, Applicants are not required to address this provisional rejection at this time, and will address this provisional rejection if and when claims 161-193 in co-pending '085 Application are allowed.

### **CONCLUSION**

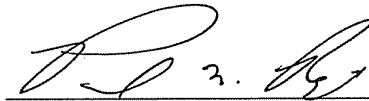
In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims in the instant application are novel and patentable over the prior art, and are in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections, and issuance of a Notice of Allowance are respectfully requested.

Should the Examiner have any questions or concerns, the Examiner is invited to contact Applicants' undersigned attorney by telephone at 412-471-8815.

Respectfully submitted,

THE WEBB LAW FIRM

By:



Paul M. Reznick  
Registration No. 33,059  
Attorney for Applicants  
700 Koppers Building  
436 Seventh Avenue  
Pittsburgh, PA 15219  
Telephone: 412-471-8815  
Facsimile: 412-471-4094  
E-mail: [webblaw@webblaw.com](mailto:webblaw@webblaw.com)